

Applicant : Shoji Kobayashi et al.
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Attorney's Docket No.: 10973-063001 / K43-
139213M/KJK

REMARKS

Claims 1-13 are pending.

Claim 1 was rejected as indefinite under 35 U.S.C. § 112, par. 2, because the language regarding the priority of information is unclear. The final paragraph of claim 1 has been amended to clarify the language using clearer English. Minor amendments to other limitations of claim 1 also have been made to improve their grammar.

Applicant requests that those amendments be entered because they should overcome the rejection under § 112, par. 1 and because they place the claims in better condition for appeal should that be necessary.

Claims 5, 6 and 7 have been rewritten in independent form to include the limitations of the claim(s) from which they depended. As those claims were not rejected over the prior art, those claims should now be in condition for allowance.

Claims 1-4, 8-9 and 11-13 remain rejected as unpatentable over U.S. Patent No. 5,562,336 (Gotou). Claim 10 is rejected over the combination of the Gotou patent and U.S. Patent No. 5,837,994 (Stam et al.). As discussed below, applicant respectfully disagrees.

The Gotou patent discloses a light distribution control ECU 20 that obtains map information, and information about the state of the road (*see, e.g.,* col. 4, lines 36-40). However, we find no suggestion of using the information that is "judged to be the more reliable" as between (i) information from the map information acquiring means and (ii) information detected by the environmental condition detection means. In particular, there is no suggestion in the Gotou patent as to judging which information is more reliable and then using that information.

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The Office action states:

Also it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only [*sic.*] requires the ability to do [*sic.*] perform. It does constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

Applicant notes that the decision in *In re Hutchinson* was rendered in 1946, several years before the current Patent Act of 1952. Moreover, even if that decision accurately reflects the present state of the law, it is irrelevant to the pending claims, which do not recite the language "adapted to."

Furthermore, if the Office action is suggesting that the "wherein" clause at the end of claim 1 is not entitled to patentable weight, then that is incorrect. The Court of Appeals for the Federal Circuit has clearly held that "wherein" clauses are entitled to patentable weight. *See, e.g., Griffin v. Bertina*, 62 USPQ2d (Fed. Cir. 2002) ("the Board did not err in giving limiting effect to the 'wherein' clauses . . .").

In view of the foregoing remarks, applicant respectfully requests entry of the amendments and withdrawal of the rejections.

The Examiner is requested to contact the undersigned attorney if any remaining issues remain to be resolved.


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Respectfully submitted,

Date: 6/9/04



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